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10/633,563

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Masashi Eguchi

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06/24/2008

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EXAMINER

LIN, WEN TAI

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,563	<b>Applicant(s)</b> EGUCHI ET AL.	
	<b>Examiner</b> Wen-Tai Lin	<b>Art Unit</b> 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-24 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-10, 14-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Togawa et al.(hereafter "Togawa") [U.S. Pat. No. 7252198].
4. As to claim 1, Togawa teaches the invention substantially as claimed including: an electronic mail server device [e.g., 11a-11b, 13a-13b, Fig. 15A-D; note that Togawa also teaches that 11a and 13a, likewise 11b and 13b can be combined as one mail server (see 11a' and 11b', Fig. 22 or col. 22, lines 15-19)] comprising:
  - means for receiving an electronic mail [e.g., Fig. 15A-D];
  - means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail [e.g., whether a corresponding new address is present and whether the mail size exceeds the destination device's limit]; and

means for controlling to execute a prescribed processing to the received electronic mail when the prescribed processing condition is satisfied [e.g., S704-S711, Fig. 7],

5. wherein the means for determining includes storing a relationship between a plurality of prescribed processing conditions related to the received electronic mail [e.g., D30, D50, D70 and D90 Fig. 19], a plurality of processings corresponding to respective prescribed processing conditions that may be performed in response to the means for determining making a determination that the prescribed processing condition is satisfied, and a plurality of conditions that specifically define the plurality of prescribed processing conditions for each of a plurality of destinations of the received electronic mail [e.g., D40, D60, D80, D100 and D110, Fig. 19], and

wherein the means for controlling executes any one of the plurality of prescribed processings in response to the means for determining making a determination that the prescribed processing condition is satisfied [e.g., the flow charts of Figs. 7-9 and 19 represent a relationship between a plurality of prescribed processing conditions of a received email that may be performed in response to determining certain processing condition is satisfied].

Togawa does not specifically teach that the relationship between the plurality of prescribed processing conditions, the plurality of processings corresponding to respective prescribed processing conditions, and plurality of conditions that specifically define the plurality of prescribed processing conditions for each of a plurality of destinations of the received electronic mail is stored in a table.

However, forming a execution – condition relationship on a table is well known in the art of problem-solving or diagnostic procedures. In presenting the response strategy of a plurality of

email problems at a server, Togawa shows in Figs. 7-9, 15 and 19 detailed condition checking and responding steps, together with the use of various managing tables and environment information tables [e.g., Figs. 4 and 16]. It would have been obvious to one of ordinary skill in the art of programming to store the aforementioned condition-processing relationship in a table because table representation (such a database) is a proven technique to information management.

6. As to claim 2, Togawa further teaches that the prescribed processing condition is when a size of the received electronic mail or an attached file exceeds a prescribed value, and when the means for determining determines that the size of the received electronic mail or the attached file exceeds the prescribed value [Abstract], the means for controlling executes at least one of presecibed processings: (a) dividing and forwarding the electronic mail [e.g., D110, Fig.19].

7. As to claim 3, Togawa further teaches that the plurality of conditions that specifically define the prescribed processing condition are sizes of the electronic mail or the attached file is a value specific to each electronic mail address or each domain of a destination of the electronic mail [e.g., Figs. 15 and 19].

8. As to claims 4 and 6, Togawa further teaches that the prescribed processing condition is when an attached file of the received electronic mail is a specific format, and when the means for determining determines that the attached file of the received electronic mail is the specific format [e.g., compressed in a specific form], the means for controlling executes at least one of

prescribed processing: (a) converting the attached file into a prescribed format and forwarding [e.g., col. 18, lines 61-67].

9. As to claims 5 and 7, Togawa further teaches that the specific format is a format which the plurality of conditions that specifically define the prescribed processing conditions are respective formats which are specific to each electronic mail address or each domain of a destination of the electronic mail [i.e., for the same reasons described in the rejection of claim 1, converting an email into an acceptable format to the receiver can be stored in Togawa's table showing the plurality of actions in response to prescribed conditions].

10. As to claim 10, Togawa further teaches that the prescribed processing condition is when specific data is included in the received electronic mail [i.e., old mail address], and when the specific data is included in the received electronic mail, the means for controlling executes at least one of following processing: (a) removing the specific data from the electronic mail and forwarding the electronic mail [e.g., col.2, lines 36- 42; that is, if a mail's address has been updated, remove the old mail address and forward the mail to the new mail address].

11. As to claim 14, Togawa further teaches that the prescribed processing condition is when receiving a plurality of divided electronic mails, and when receiving the plurality of divided electronic mails, the means for controlling restores the received plurality of divided electronic mails into one electronic mail, and forward the electronic mail [Figs. 8-10].

12. As to claim 15, Togawa further teaches that the means for controlling receives data which defines the processing condition and processing corresponding to the processing condition from a remote device under a prescribed communication protocol [e.g., paragraph 10; i.e., the content of preference information is entered by remote subscribers].

13. As to claims 8-9, 16-21 and 24, since the features of these claims can also be found in claims 1-2, 4, 6-7, 10 and 14, they are rejected for the same reasons set forth in the rejection of claims 1-2, 4, 6-7, 10 and 14 above.

14. Claims 11-12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Togawa et al.(hereafter "Togawa")[U.S. Pat. No. 7252198], as applied to claims 1-10, 14-21 and 24 above, further in view of Katsikas [U.S. PGPub 20050188045].

15. As to claim 11, Togawa does not specifically teach the prescribed processing condition is when a transmitter terminal of the received electronic mail is a specific address or a specific domain, and when the means for determining determines that the transmitter terminal of the received electronic mail is the specific address or the specific domain, the means for controlling executes at least one of prescribed processing:

(a) forwarding the electronic mail to a prescribed destination; (b) returning the electronic mail to the transmitter terminal; (c) blocking a reception of the electronic mail; and (d) printing the electronic mail.

However, Katsikas teaches that when the received mail is determined to be a spam, forward the mail to a prescribed destination [e.g., 211, Fig. 4B].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the aforementioned spam mail processing in Togawa's relationship table (as one of the plurality of mail conditions) with a corresponding prescribed processing such as forwarding the spam mail to a prescribed destination because adding spam mail handling in Togawa's system would expand the system's capability of handling spam mail further prevent Togawa's users from receiving undesirable mails.

16. As to claim 12, Katsikas further teaches that the prescribed processing condition is when a transmitter terminal of the received electronic mail is neither a specific address nor a specific domain, and when the transmitter terminal of the received electronic mail is neither the specific address nor the specific domain, the means for controlling executes at least one of following processing: (a) forwarding the electronic mail to a prescribed destination [e.g., Katsikas: paragraphs 25 and 34-35].

17. As to claim 22, since the features of this claim can also be found in claims 1 and 11, it is rejected for the same reasons set forth in the rejection of claims 1 and 11 above.

18. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Togawa et al.(hereafter "Togawa")[U.S. Pat. No. 7252198], as applied to claims 1-12, 14-22 and 24 above, further in view of Official Notice .



19. As to claim 13, Togawa does not specifically teach what to do when failing to forward the received electronic mail.

However, Official Notice is taken that it is well known fail-to-delivered emails are normally returned to their respective senders.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to return a fail-to-delivered email back to its sender because it alerts the sender of the failure such that new delivery method may be attempted.

20. As to claim 23, since the features of this claim can also be found in claims 1, 13 and 17, it is rejected for the same reasons set forth in the rejection of claims 1, 13 and 17 above.

**21.** A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 23, 2008

/Wen-Tai Lin/

Primary Examiner, Art Unit 2154

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